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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Miracom Corporation

Serial No. 75/915,846

Sheldon H. Parker of Parker & DeStefano for Miracom Corporation.

William Patrick Shanahan, Trademark Examining Attorney, Law Office 116 (Meryl Hershkowitz, Managing Attorney).

Before Cissel, Hanak and Chapman, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

On February 10, 2000, Miracom Corporation (a Florida corporation) filed an application to register on the Principal Register the mark shown below

parts.com

for services ultimately amended to read "computerized on-line ordering services and membership-based inventory exchange services in the area of automobile products" in International Class 35.[1] The application is based on applicant's claimed date of first use and first use in commerce of February 23, 1999.

Citing Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), the Examining Attorney refused registration on the ground that when applicant's asserted mark is used in connection with the identified services, it is merely descriptive thereof.

When the refusal was made final, applicant appealed, and both applicant and the Examining Attorney have filed briefs. Applicant did not request an oral hearing.

The Examining Attorney argues that the proposed mark

parts.com

is merely descriptive of applicant's services because it

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[1] In the original application, the identification of services read "providing access to automotive replacement items via the global computer network." In response to the first Office action, applicant proposed the following identification, which was not accepted by the Examining Attorney: "computerized business networking, on-line ordering and inventory management services, and membership-based inventory exchange services in the field of automotive replacement parts." In response to the second Office action, applicant filed the second proposed amendment, recited above, to the identification of services, which was accepted.

immediately informs consumers of a significant feature and purpose of applicant's on-line ordering and inventory exchange services which relate to automobile parts; that applicant's services cannot exist without an inventory and a database subject matter, which is "parts"; that the word "parts" is generic for the products to which applicant's services relate and ".com" is a top level domain with no trademark significance; that the combination thereof does not change the connotation of "parts.com," nor does it create a unique or incongruous mark; and that consumers seeking applicant's services of on-line ordering and inventory exchange of automobile parts will immediately understand that "parts.com" indicates a commercial website that provides such services.

In support of his position, the Examining Attorney submitted a Random House College Dictionary (Revised First Edition 1982) definition of "part" as "10. a constituent piece of a machine or tool either included at the time of manufacture or set in place as a replacement for the original piece."[2] In addition, the Examining Attorney

[2] This evidence was submitted with the Examining Attorney's brief, along with his request that the Board take judicial notice thereof. The Examining Attorney's request is granted. See The University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc., 213 USPQ 594 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). See also, TBMP §712.01.

relies on (i) applicant's identification of services which specifically references and is thus limited to "...in the area of automobile products"; (ii) applicant's specimens of record--advertisements, one of which is a printout of a page from applicant's website, and another of which is a photocopy of an advertisement appearing in a publication published on behalf of applicant; and (iii) additional pages from applicant's website submitted by applicant in response to the refusal to register.

Applicant's published advertisement specimen includes the statement "PARTS.COM Getting auto parts… is now child's play." The additional web pages submitted by applicant include the following statements:

> Parts.com provides a business-to-business e-commerce solution for the $600 billion auto parts industry. ...its unique, direct business model which eliminates a number of inefficient links in the supply chain inherent in the auto parts business. "corporate.parts.com/news/2000"; and
>
> ...At parts.com, consumers find the parts they need, superior pricing, and fast delivery without paying a penny in membership or registration fees. "corporate.parts.com/products/parts."

Applicant explains its involved services as follows:

> The applicant has created a business-to-business network and database, accessed via the Internet, whereby member automotive parts dealers and

> distributors can manage and exchange their inventories to increase their own business opportunities. For the benefit of its members, the applicant's database is also made available to non-member consumers to assist them in locating dealers who have the items they desire in stock.
> (Brief, pp. 1-2.)

Applicant urges reversal of the refusal to register, arguing that it provides a database service, not a parts service; that the word "parts" has many different meanings (e.g., "an actor's lines in a play," response filed June 1, 2001, p. 2); that even if "parts" may be seen by consumers as referring to parts for machines, it is not obvious that the reference is to automobile parts, and it could be understood to refer to parts for other machinery; that it takes a multi-stage reasoning process to interpret the mark, in its entirety, as merely descriptive of a feature or purpose of applicant's services; and that ".com" is not being used merely as a domain name identifier because it is in the name of applicant's subsidiary, Parts.com, Incorporated (a Nevada corporation).

Applicant submitted photocopies of two registrations issued by the USPTO for the marks BOOKS.COM (Registration No. 2,223,338) and HOMES.COM (Registration No. 2,226,864) as evidence that the Office has previously registered such marks. However, both of these registrations issued on the

Supplemental Register, and are of no probative value in determining the registrability of the mark now before us on the Principal Register.[3]

The well-established test for determining whether a term or phrase is merely descriptive under Section 2(e)(1) of the Trademark Act is whether the term immediately conveys information concerning a significant quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used. See In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); In re Omaha National Corp., 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); and In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215 (CCPA 1978). The determination of mere descriptiveness must be made not in the abstract, but rather in relation to the goods or services for which registration is sought, the context in which the term or phrase is being used on or in connection

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[3] In its brief on appeal, applicant referenced for the first time four additional registrations. This evidence is untimely pursuant to Trademark Rule 2.142(d). Moreover, applicant included only a typed listing of the four registration numbers and marks. Such typed listings are insufficient to make the registrations of record. See In re Duofold, Inc., 184 USPQ 638 (TTAB 1974). The Board has not considered applicant's typed listing of four third-party registrations. We hasten to add that even if considered, they would not alter our decision herein. See In re Nett Designs Inc., 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001).

with those goods or services, and the possible significance that the term or phrase would have to the average purchaser of such goods or services in the marketplace. See In re Abcor Development Corp., supra; In re Consolidated Cigar Co., 35 USPQ2d 1290 (TTAB 1995); In re Eden Foods Inc., 24 USPQ2d 1757 (TTAB 1992); and In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979). Furthermore, such question is not whether someone presented with only the term or phrase could guess what the goods or services are. Rather, the question is whether someone who knows what the goods or services are will understand the term or phrase to convey information about them. See In re Home Builders Association of Greenville, 18 USPQ2d 1313 (TTAB 1990); and In re American Greetings Corp., 226 USPQ 365 (TTAB 1985).

Upon careful consideration of this record and the arguments of the attorneys, we agree with the Examining Attorney that applicant's mark, when used in connection with applicant's identified services, immediately describes, without conjecture or speculation, a significant feature and/or purpose of applicant's service of providing on-line ordering and inventory exchange for automobile products. The dictionary definition of "parts" and the wording appearing on applicant's specimens of record and its web pages establish that the designation "parts.com" is

readily understood by the relevant purchasing public as relating to applicant's on-line services involving automobile replacement parts. There is no question but that a central feature of applicant's services, as described in the application and as actually offered, is the ability to order and exchange inventory of automobile replacement parts. As such, the asserted mark "parts.com," consisting of the generic word "parts" and the top level domain name ".com" (which is a part of an address indicating that applicant is a commercial entity), merely describes applicant's automobile replacement parts ordering and inventory exchange services. See In re Gyulay, supra; In re Omaha National Corp., supra; In re Putnam Publishing Co., 39 USPQ2d 2021 (TTAB 1996); In re Time Solutions, Inc., 33 USPQ2d 1156 (TTAB 1994); and In re Copytele Inc., 31 USPQ2d 1540 (TTAB 1994). See also, In re Martin Container Inc., 65 USPQ2d 1058 (TTAB 2002)(the Board held the term CONTAINER.COM incapable of distinguishing applicant's services and hence unregistrable on the Supplemental Register); and In re Eilberg, 49 USPQ2d 1955 (TTAB 1998)(the Board held the term WWW.EILBERG.COM incapable of distinguishing applicant's services and hence unregistrable on the Supplemental Register).

Applicant's argument that its use of "Parts.com, Incorporated" as the name of a subsidiary corporation somehow creates or confirms some trademark significance in the ".com" portion of applicant's mark is simply unpersuasive. Based on the evidence of applicant's use of the ".com" designation in this record, we cannot agree that that portion of applicant's mark carries any trademark significance. Rather, the ".com" portion of applicant's mark is merely part of a domain address, and lacks trademark significance. See 555-1212.com, Inc. v. Communication House International, Inc., 157 F.Supp. 2d 1084, 59 USPQ2d 1453 (N.D.CA. 2001); In re Page, 51 USPQ2d 1660 (TTAB 1999); and 1 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §7:17.1 (4th ed. 2001).

Furthermore, we find that here the term unquestionably projects a merely descriptive connotation, and we believe that competitors have a competitive need to use this term. See In re Tekdyne Inc., 33 USPQ2d 1949, 1953 (TTAB 1994), and cases cited therein. See also, 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §11:18 (4th ed. 2001).

Decision: The refusal to register the mark as merely descriptive under Section 2(e)(1) is affirmed.